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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HAYES, SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/825,219	Applicant(s) LUDWIG ET AL.	
	Examiner Dan Kesack	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☒ Claim(s) 4,7,13 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-34 are currently pending. The rejections are as stated below.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 09/825,234. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain identical elements payment processing system, database including global information related to two entities, and a modular business object that is replaceable with another modular business object using the same global information.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

4. Claims 4, 7, 13, and 30 are objected to because of the following informalities:
Claims 4, 7, 13, 30, recite "said business object," which Examiner assumes is a reference to the "modular business object" of claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 3, 8, 9, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 3, recite the limitation "said data" in claim 1. There is insufficient antecedent basis for this limitation in the claim, as claim 1 makes no mention of any "data".

Claims 8, 9, 11, recite, "said selected business object in claim 1. There is insufficient antecedent basis for this limitation in the claim, as claim 1 makes no mention of a "selected business object," or of any such object being selected.

7. Claims 5 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites "a business service provider system; said business service provider system configured to provide business processing services". This claim is regarded as indefinite for failing to distinctly claim the scope of a "business processing service", as enabled by the specification.

Claim 12 recites "said payment processing system being further operable to translate invoice data." The term "translate" renders the claim indefinite because one of ordinary skill in the art is unable to ascertain how said invoice data is translated, and therefore the claim is indefinite as to the structure required to meet said claim.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine,

manufacture, or composition of matter, or any new and useful improvement thereof"
(emphasis added).

Claims 1 and 2 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the claimed invention as a whole does not accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention. The mere fact that the payment processing system comprises a modular business object, and the modular business object is replaceable with another modular business object does not satisfy the requirement of 35 U.S.C. 101. The claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore is non-statutory under 35 U.S.C. § 101. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-7, 12-21, 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitchen, et al., U.S. Patent No. 6,289,322.

Claims 1, 2, Kitchen discloses a payment processing system comprising a database including global information relating to a biller system and a payor system (column 6 lines 36-49), at least one modular business object containing specified instructions using the same global information, wherein said modular business object is replaceable with another modular business object containing other specified instructions using the same global information (column 7 lines 6-17). Kitchen further teaches the at least one modular business object containing specified instructions to modify said global information (figures 4 and 5).

Claim 3, 7, Kitchen teaches the payment processing system being in communication with at least one payor system and at least one payee (figure 1), wherein the system is operable to receive invoice data from the biller system and store said data on said database, and to provide access to the business object (column 6 lines 50-58).

Claim 4, Kitchen teaches the payment processing system is further operable to permit said payor system to select one said business object for execution and to execute said object (column 8 lines 12-15).

Claim 5, Kitchen teaches a business service provider configured to provide business processing services to said biller system and said payer system via said payment processing system (figures 1, 2 #130a-c).

Claim 6, Kitchen teaches the payment processing system is operable to send an e-mail message to alert the payor of updated invoice data (column 7 lines 6-17).

Claim 12, Kitchen teaches the payment processing system translating invoice data received from the biller system prior to storage on the database (figure 7, #170 and column 6 lines 50-54).

Claim 13, Kitchen teaches the business object being an object for reviewing invoices, and an object for initiating invoice payment (figures 7, 11, and 12).

Claims 14-16, 18, Kitchen teaches the payment processing system being capable of connection to a network, said payment processing system comprising hardware and software for connecting to said network, and the network consisting of a wide area network, Internet, private or public network (column 5 line 66 – column 6 line 49).

Claim 17, Kitchen teaches the payment processing system operable to perform the actions of transmitting to said payor system said invoice data, adjudicating said invoice data, and allowing the payor system to pay said biller system (figure 7).

Claim 19, Kitchen teaches the payment processing system comprising memory adapted for receiving and storing data and commands from said biller system and said payor system via said network (figure 2A).

Claim 20, 21, 28, 29, Kitchen teaches a security mechanism in the form of a user name and password for restricting unauthorized access (figure 6).

Claim 27, Kitchen teaches said invoice data comprising a payor system, an invoice stream, and a biller system identifier (column 6 lines 59 – column 7 line 5).

Claims 30-32, Kitchen teaches an application server, at least one business object residing on said application server (figure 2A, #420a-f), an invoice loader and a business selection object (figure 2A, #410).

Claim Rejections - 35 USC § 103

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11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 8-11, 22, 24-26, 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen, as applied to claim 1 above.

Claims 8-11, 33-35, Kitchen fails to teach the use of extensible markup language (XML) and structured query language (SQL) in the generation of messages, presentment of data, and formation of responses.

Official Notice is taken that the use of XML and SQL in generation of database messages, and the presentment of online data, particularly related to bill presentment and payment systems, is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the bill payment and processing system of Kitchen to include the use of XML and SQL to send

and receive messages, to interact with the database, and to present data because the programming languages are standards for system formation in the industry.

Claim 22, Kitchen fails to teach the use of a firewall in the system.

Official Notice is taken that the use of a firewall to protect billing and payment systems, as well as individual communication devices is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the bill payment and processing system of Kitchen to include the use of a firewall because the protection and security provided by a firewall is a desirable and necessary feature of any network based billing and payment system in order to ensure secure transactions.

Claims 24-26, Kitchen teaches the biller, payor, and service provider systems accessing the payment processing system via the Internet. Kitchen fails to teach the use of a browser.

Official notice is taken that the use of a browser to connect to the Internet is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Kitchen to specify the use of a browser because a browser is the standard tool used to connect to the Internet using a communications device.

14. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen, as applied to claim 1 above, and further in view of Zervides, U.S. Patent No. 6,052,674.

Kitchen fails to teach a mechanism for storing a mirror copy of said data stored on said database and permitting access to said mirror copy of said data in the event the original data is corrupt or unavailable.

Zervides discloses an electronic invoicing and collection system, comprising a security computer mirror copying all data and serving as a backup data storage device (column 9 line 54 – column 10 line 6). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the bill payment and processing system of Kitchen to include the use of a data backup because data backup in electronic billing and payment is desirable and important to safeguard against the loss of data in the event of a computer failure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER